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09/054,180	04/01/1998	BRIAN J. REISTAD	06543035001	2217
24573 7590 09/21/2007 BELL, BOYD & LLOYD, LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER ELISCA, PIERRE E	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/054,180
Filing Date: April 01, 1998
Appellant(s): REISTAD ET AL.

MAILED

SEP 21 2007

GROUP 3600

PETER ZURA
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/16/2007 appealing from the Office action mailed 06/14/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

CLAIM OBJECTION

Claims 19-32 and 46-60 are objected to because of the following informalities:

Claims 19-32 and 46-60, claim dependency on claims 3 and 37 which were previously canceled in the application. Appropriate correction is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-36 and 39-63 are rejected under 35 U.S.C. 102 (e) as being anticipated by Barnett et al (U.S. Pat. No. 6,321,208).

As per claim 12, Barnett discloses an electronic commerce system (provided is a system for distributing and generating at a remote site product redemption coupons) comprising a client computer (user's remote personal computer, 6) and a server computer (online provider, 2) (see., fig 1) the client computer and the server computer being interconnected by a public packet switched communications network (internet) (see., fig 1) the client computer being programmed to transmit to the server computer an order acceptance request (request for coupon) comprising a plurality of terms or conditions of a proposed offer for a purchase, the order acceptance request comprising

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a discrete message that includes at least one of the modular elements (coupons fig 5) individually protected by a cryptographic security code being a digital coupon (the coupons 18 contain user-specific data in the form of a unique user bar code encoded with user-specific information such as the user name and/or other unique identification criteria such as social security number or online service address) see figs 1, 2, 5, col 7, lines 20-55), the server computer being programmed to process the order acceptance request based on pre-programmed criteria including authentication and examination (verifies the value of the redeemed coupons, determines the identification of users who redeemed the coupons) of the cryptographic security codes embedded within each of the modular elements and examination of the modular elements of the discrete message individually protected by the cryptographic security codes (unique user bar code encoded with user-specific information), and, based on the processing of the order acceptance request, to transmit to the client computer an order acceptance response based on the pre-programmed criteria, the order acceptance response comprising a discrete message transmitted during a negotiation phase of a transaction that includes a plurality of modular elements whose individual integrity is protected by embedding cryptographic security codes within each of the modular elements (see figs 1, 2, 5, col 7, lines 20-55), wherein the client computer is programmed to receive the digital coupon, protected by a cryptographic security code, from another computer (coupon distributor, 16) (see fig 1).

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As per claims 13 and 42 Barnett discloses a system wherein the client computer is programmed to provide information to the server computer concerning identify of the coupon holder (see figs 1, 2, 5, col 7, lines 20-55).

As per claims 14-18 and 43-45 Barnett discloses a system wherein the server computer is programmed to authenticate authority of the client computer by virtue of a two-way-authenticated SSL connection using a basic authentication method such as a client certificate (see., fig 1).

As per claims 19 and 46 Barnett discloses a system wherein the digital coupon contains a serial number to ensure that the digital coupon is used only once and the server computer is programmed to determine whether the digital coupon has been used previously and to accept the digital coupon only if it has not been used previously (see figs 1, 2, 5, col 7, lines 20-55).

As per claims 20 and 47 Barnett discloses a system wherein the server computer is programmed to set at least one term of the order acceptance response based on whether the digital coupon is present in the order acceptance request (see., figs 1, 2, 5, col 7, lines 20-55).

As per claims 21 and 48 Barnett discloses a system wherein the at least one terms of the order acceptance response is a price (see., figs 1, 2, 5, col 7, lines 20-55).

As per claims 22-24 and 49-51 Barnett discloses a system wherein the server computer is programmed to set at least one term of the order acceptance response based on whether the digital coupon in the order acceptance request is a particular type digital coupon (gift certificate comprises a serial number).

As per claims 25 and 52 Barnett discloses a system wherein the server computer is programmed to ensure that the serial number has been used only once by checking a database in which the serial number is stored (see figs 1, 2, 5, col 7, lines 20—5).

As per claims 26 and 53 Barnett discloses a system wherein the client computer is programmed to display an icon of the gift certificate and to initiate the order acceptance request after a recipient of the gift certificate clicks on the icon (see figs 1, 2, 5, col 7, lines 20-55).

As per claims 27 and 54 Barnett discloses a system wherein further comprising a merchant computer, the merchant computer being programmed to respond to the recipient clicking on the icon by transmitting an order form to the client computer, the client computer being programmed to initiate the order acceptance request when the recipient fills in the order form (see fig 1).

As per claims 28 and 55 Barnett discloses a system wherein the client computer is a first client computer programmed to receive the gift certificate from a second client computer (see fig 1).

As per claim 29 and 56 Barnett discloses a system wherein the server c programmed to transmit the gift certificate to the second client computer, which in turn is programmed to forward the gift certificate to the first client computer (see fig 1).

As per claims 30 and 57 Barnett discloses a system wherein the gift certificate comprises a serial number and the server computer is programmed to create the serial number of the gift certificate before transmitting the gift certificate to the second client computer (see fig 1).

As per claims 31 and 58 Barnett a system wherein the server computer is programmed to store the serial number in a database before transmitting the gift certificate to the second client computer, and is programmed, when it receives the gift certificate from the first client computer to ensure that the serial number has been used only by checking the database in which the serial number is stored (see figs 1, 2, 5, col 7, lines 20-55).

As per claims 32 and 59 Barnett discloses a system further comprising a merchant computer programmed to transmit the gift certificate to the server computer before the server computer transmits the gift certificate to the second client computer (see fig 1).

As per claims 33 and 60 Barnett discloses a system wherein the merchant computer is programmed to transmit the gift certificate to the server computer in the form of an order acceptance request that includes extension information indicating that the order acceptance request is a gift certificate (see fig 1, 2, 5, col 7, lines 20-55).

(10) Response to Argument

Applicant's arguments filed on 3/29/2006 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art of record (Barnett) fails to disclose a system wherein a client computer configured for transmitting an order acceptance request over a network including a plurality of modular element that is individually encrypted wherein the order of acceptance including modular elements whose integrity is protected by security code. Examiner respectfully disagrees with Applicant characterization of the prior art. Barnett discloses among other thing a shopping list function button calls the shopping list generation routine when selected by the user. This routine will allow the user to generate a list from a menu presented on the screen whichever items the user desires to purchase. And the user can store and/or print this list as desired. The items on the list are compared against coupon data stored in the coupon database and the user is informed of their existence. The user may then print out those coupons along with the shopping list. Alternatively, the user may select certain coupons for printing, and the item associated therewith is automatically placed on the shopping list. Thus, in

either fashion, the user's shopping list generation and coupon "clipping" tasks are conveniently merged in a timesaving manner. Examiner disagrees that the bar code provide in the present invention is irrelevant to the cryptographic encoding in the present application. Barnett's coupons contain user-specific data in the form of a unique user bar code. The user bar code is encoded with user-specific information such as name and/or other unique identification criteria such as a social security number or online service address (emphasis added). This information renders each printed coupons unique, since an otherwise similar coupon presented by a different consumer will comprise a different user bar code. The use of a unique coupon is but one aspect of the secure nature of the present invention as will be described in detail below. Barnett further indicates that the unique user bar code renders the electronic coupon system of the present invention secure and virtually fraud-proof. Although a user is able to print out a particular coupon only once (to be described in detail below), the coupon issuer could still be defrauded by a user or retailer who might photocopy a printed coupon numerous times and fraudulent and repeatedly present it for redemption. However, in accordance with the present invention, each coupon printed by a user is unique, and the scanning of a coupon presented for redemption will be stored at the coupon redemption center. Thus, the coupon issuer will know if a particular user has redeemed a particular coupon and thus disallow further redemption of a photocopied coupon bearing the same indicia.

b. For the reason state above this action is made final.

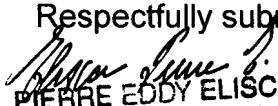
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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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